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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/699,984

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Taku Aida

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EXAMINER

JOHNS, CHRISTOPHER C

ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/699,984	AIDA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Christopher C. Johns	3621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Acknowledgements***

1. Claims 1 and 6 are pending.
2. This Office action is given Paper No. 20090210 for reference purposes only.
3. All references to the capitalized version of “Applicant” refer specifically to the Applicant or Applicants of record in the instant application. Any references to lowercase versions of “applicant” or “applicants” refer to any or all patent applicants. Unless expressly noted otherwise, references to the capitalized version of “Examiner” refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally. The notations in this paragraph apply to any future Office actions from this Examiner.

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2 January 2009 has been entered.

### ***Claim Objections***

4. Claims 1 and 6 are objected to for usage of the functional language “operable to”. It is believed that Applicants intend “operable to” to mean “programmed to” since “operable to” is functional language and therefore given less patentable weight. In light of the notice function of the claims, the Examiner respectfully requests changing “operable to” to “programmed to” where a positive recitation is desired<sup>1</sup>.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 6 are rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent Application Publication 2002/0157002 ("Messerges") in view of Official Notice.

7. As per claims 1 and 6, Messerges discloses:

8. server (figure 2, reference 210) operable to provide software via a network (figure 2, reference 216 - "Gateway Service") to a plurality of electronic devices (figure 2, reference 216 -

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<sup>1</sup> See MPEP §2114 - “While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function” (emphasis mine). The Manual then cites important precedent: “*In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board’s finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “Apparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).”

"Domain") in response to a request to purchase or transfer the same (§38 - "any portable device can request a piece of this content");

9. at least two electronic devices (figure 2, reference 216, "Domain"; figure 3, reference 216, portable devices), each of the devices being identified by device identification information (figure , reference 202<sub>2</sub>) registered in association with user identification information identifying a single user (figure 4, reference 410) such that each of the devices have the same user associated therewith (§27 - "domain-based approach in which the user must contend with security only when a new user device is to be purchased or added to a domain or when an old user device is to be removed from a domain");

10. devices including requesting means for sending user identification information (§37 - "content provider can query the user device...to authenticate a particular domain"), device identification information (§77 - "user device's private key"), software identification information (§38 - "Any portable device can request a piece of the content"), to the server to request the software be provided and that a license request to run the software be generated based on predetermined license generating information and be provided to the electronic device (§48 - "only be available to the owner or purchaser of the content"; §49 - "As indicated by the dashed line, the objects of the content package...license file containing the content provider header...encrypted content");

11. installing means for installing the selected software provided from the server (§38 - "host merely transfers the content to the requesting device without performing a check-out operation");

12. requesting means for requesting that the server transfer the software from the device to another of the devices having the same user associated therewith (§38 - "any portable device can request a piece of this content");
13. server including registering means for registering the software identification information for the selected software in association with the user identification information and device identification information for the device on condition that the user and device information have been registered in association with one another (§38 - "devices outside of this domain cannot access content that was cryptographically tied to another domain, so this content is safe from piracy");
14. providing means for providing the selected software to the device (§38 - "host merely transfers the content to the requesting device without performing a check-out operation");
15. generating means for generating the license when the software, device, and user information have been registered in association with one another (§48 - "only be available to the owner or purchaser of the content"; §49 - "As indicated by the dashed line, the objects of the content package...license file containing the content provider header...encrypted content");
16. transferring means for, upon a request by the third requesting means of the electronic device to transfer the software, deleting the software identification information for the software and the user and device information registered in association with the software information for the respective device (§70 - "if the user wishes to remove a device from a domain..."), and registering the software information for the software in association with the device information for the other electronic device and the user information, such that the respective device is prohibited from purchasing software (if the device is not part of a domain, it cannot acquire or

purchase content on behalf of that domain) and such that the other device is allowed to run the software (§38 - "devices outside of this domain cannot access content that was cryptographically tied to another domain, so this content is safe from piracy").

17. Messerges does not explicitly disclose:

18. means for causing information to be supplied to the respective electronic device which identifies each device currently available to receive the selected software by transfer if a request to do so is made, and transferring software to a device which is selected by use of the information which identifies said each electronic device currently available to receive the selected software by transfer.

19. The Examiner takes Official Notice that sending information concerning all currently-authorized devices was old and well-known in the art, because it allows for a system where a user can see which devices are currently authorized to operate in the domain. As users in Messerges are permitted to have a finite number of devices in their domains (§38 - "limited number of devices into each domain"), knowing which devices are able to render content is advantageous to users because it would allow them to understand whether their preferred devices are able to render the content - e.g. if a user is going on a long trip and wants to make sure that his mobile music player is authorized (but knows that his hi-fidelity system is authorized), the user can check the system to see whether he should authorize the portable system before leaving on his journey.

20. The Examiner further takes Official Notice that transferring via a selection was old and well-known in the art because it allows for a more robust and functional system. By having the

ability to send content between devices in a domain, the system obviates the problem of having to go to the content distributor in order to acquire the same content multiple times. If content resides on a device A but does not reside on device B, and device B is unable to access the Content Provider, allowing device A to perform an intra-domain transfer would allow the system to operate in a faster manner.

21. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Messerges the listing of authorized devices and selection of an authorized destination, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, and would understand this to be advantageous because it would create a faster and more convenient system.

### ***Claim Interpretation***

22. In accordance with MPEP §2111.01, the Examiner has interpreted the meaning of claim limitations in accordance with their "plain meaning", unless such terms have been defined explicitly in the specification.

23. As per the above objections to claims 1 and 6, the limitation of "server" merely notes that it is "operable" to perform certain steps. This limitation, while permissible in a system claim, is objected to because it does not precisely capture what the Examiner believes that the Applicants wish to claim. A server "operable to" perform steps is only claiming that the server is able to be operated in such a fashion - as such, nearly any computer would be able to "provide software via



a network...". The Examiner believes that Applicants are not attempting to claim any typical computer; rather, they are trying to claim the specific type of server that has been programmed to provide software. Therefore, claiming a server that is "programmed to provide software via a network..." is more in line with what the Examiner believes Applicants are trying to claim.

### ***Conclusion***

24. **Examiner's Note:** Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. Furthermore, it must be noted that the documents cited on any enclosed PTO-892 or PTO-1449 form are cited in their entirety.

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

26. United States Patent Application Publication 20060131397 (Reddy et al), concerning a multiple-device domain DRM system. See especially figure 6, and ¶24 ("transfer rights"), 33 ("groups of end users in trusted community") 52 ("generation of licenses"), and 63 ("generate a license").

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462.

The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

28. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher C Johns/  
Examiner, Art Unit 3621

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621